



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,202	12/10/1999	YUKIKAZU MORI	2271/60882	9787

7590 08/13/2003

IVAN S KAVRUKOV ESQ
COOPER & DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

LEE, TOMMY D

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/459,202	MORI, YUKIKAZU	
	Examiner Thomas D. Lee	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-31 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) Claim(s) ____ is/are allowed.

6) Claim(s) 1-31 is/are rejected.

7) Claim(s) ____ is/are objected to.

8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 10 December 1999 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.

4) Interview Summary (PTO-413) Paper No(s) ____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. Claims 30 and 31 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 30 recites a feature identical to the feature recited in claim 29, from which claim 30 depends. Claim 31, which depends from claim 30, recites the same feature as the other two claims.

Double Patenting

4. Applicant is advised that should claims 12 and 13 be found allowable, claims 18 and 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after

allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,052,445 (Bashoura et al.).

Regarding claim 1, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality communication modes for transmitting designated image information to a designated destination, said device comprising: input means for inputting information identifying a plurality of addresses and for designating one address among said plurality addresses (column 3, line 63 – column 4, line 7); and address information registering means for registering a plurality of address information respectively corresponding to said plurality of communication modes, for each designated destination (column 4, lines 8-20).

Regarding claim 9, Bashoura et al. teach a network facsimile device comprising: Internet image information communicating means for performing communication of image information through the Internet (column 2, lines 51-56); and public network

image information communication means for performing communication of the image information through a public network, wherein said Internet image information communication means and said public network image information communicating means communicate information to a plurality of designated destinations (column 2, lines 56-61); input means for inputting information identifying a plurality of addresses and for designating one address among said plurality of addresses (column 3, line 63 – column 4, line 7); and address information registering means for registering a plurality of address information respectively corresponding to said Internet image information communicating means and public network image information communicating means, for each designated destination (column 4, lines 8-20).

Regarding claims 10 and 11, Bashoura et al. teach a network facsimile device comprising: electronic-mail type Internet image information communicating means for performing communication of the image information through the Internet by use of electronic mail (column 4, lines 27-38); real-time type Internet image information communicating means for performing communication of image information through said Internet in real time (column 4, lines 21-26, 34-38); and public network image information communicating means for performing communication of image information through a public network (column 2, lines 56-61), wherein either one of said electronic-mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means communicate information to a plurality of designated destinations addresses (column 4, line 43 – column 5, line 13); and input means for

inputting information identifying a plurality of addresses and for designating one address among said plurality of addresses (column 3, line 63 – column 4, line 7); and address information registering means for registering a plurality of address information respectively corresponding to said electronic-mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means, for each designated destination (column 4, lines 8-20). Said plurality of registered address information include an e-mail address for use by said electronic-mail type Internet image information communicating means, an IP address for use by said real-time type Internet image information communicating means, and a telephone number for use by said public network image information communicating means (Fig. 4).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claim 1 above, and further in view of U.S. Patent 6,437,871 (Yuki).

Bashoura et al. do not teach display means, wherein, when said input means is repeatedly operated at the time of designating the address, a plurality of address information registered are changed over and viewed on said display means in order, as

recited in claim 2, or one-touch dial means for enabling a large number of addresses to be registered and to designate the one address by operating the one-touch dial means, as recited in claims 5 and 6. Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al., by providing a one-touch dial memory such as taught by Yuki. Repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art.

9. Claims 12-14, 18, 19, 21/(9-14, 18, 19) (claim 21 as depending from any one of claims 9-14, 18 or 19) and 25/14 rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claims 9-11 above, and further in view of Yuki.

Claims 12-14, 18 and 19 each recite the display means of claim 2, and claims 21 and 25 each recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

10. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claim 1 above, and further in view of U.S. Patent 5,381,527 (Inniss et al.).

Regarding claim 3, Bashoura et al. do not teach setting each of a plurality of address information registered by said address information registration means with a transmission priority indicating an order in which communication modes are to be used for transmitting the designated image information to the designated destination, as recited in claim 3. Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by providing means for setting a priority order for communicating messages, such as taught by Inniss et al.

Claim 4 further recites repeatedly operating the same key at the time of selecting the address, thereby changing over and selecting plural address information registered on said key in accordance with said transmission priority order. As mentioned above with respect to claim 2, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information according to a priority order would have been a obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination.

11. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claims 9-11 above, and further in view of Inniss et al.

Claims 15-17 each recite the setting means of claim 3, and are thus rejected for the reasons set forth above.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al. as applied to claim 4 above, and further in view of Yuki.

Claim 8 recites the one-touch dial means of claims 5 and 6. As mentioned above, Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Bashoura et al. and Inniss et al., by providing a one-touch dial memory such as taught by Yuki.

13. Claims 20, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al.

As mentioned above with respect to claim 2, Bashoura et al. do not teach repeatedly operating the same key at the time of designating the address, thereby changing over and selecting, in order, a plurality of address information registered in said key (claim 20 does not recite display means, and is thus not rejected in view of

Art Unit: 2624

Yuki). However, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information in order would have been a obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing address information. Accordingly, claim 20 is rejected for the reasons set forth above with respect to claim 2.

Claim 22 recites the features of above-rejected claim 10, and further recites the repeated operation of input means similarly recited in claim 20, and is thus rejected, along with corresponding method claim 26, for the reasons set forth above.

14. Claims 21/20 and 25/22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claims 20 and 22 above, and further in view of Yuki.

As mentioned above, claims 25 recites the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

15. Claims 23, 24, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al.

Claim 23 recites the features of above-rejected claim 10, and further recites registering respective transmission priority orders for each of said mail address, said IP address, and said telephone number; wherein either one of said electronic-mail type Internet image information communicating means, said real-time type Internet image information communication means, and said public network information communicating means is selected in accordance with the transmission priority order respectively

registered with said mail address, said IP address, and said telephone number, for image information transmission to the address selected by operation of said input means. As mentioned above with respect to claim 3, Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by providing means for setting a priority order for communicating messages, such as taught by Inniss et al. Accordingly, device claim 23, as well as corresponding method claim 27, is rejected.

Claim 24 recites most of the features of claim 23, and further recites repeated operation of input means, thereby changing over and selecting plural addresses in accordance with a transmission priority order. As mentioned above with respect to claim 4, providing a key for changing and selecting address information according to a priority order would have been a obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination. Accordingly, device claim 24, as well as corresponding method claim 28, is rejected.

16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al. as applied to claim 3 above, and further in view of Yuki.

Claim 7 recites the one-touch dial means of claims 5 and 6. As mentioned above, Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Bashoura et al. and Inniss et al., by providing a one-touch dial memory such as taught by Yuki.

17. Claims 21/(15-17) and 25/(15, 23, 24) are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al. as applied to claims 15-17, 23 and 24 above, and further in view of Yuki.

As mentioned above, claims 21 and 25 each recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

18. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al. as applied to claim 28 above, and further in view of Yuki.

Claims 29-31 each also recite the one-touch dial means of claims 5 and 6, and thus are rejected as well, for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-

4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
August 8, 2003